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In re Application of: :
Dib-Hajj et al. :
Serial No.: 09/856,274 : PETITION DECISION
Filed: May 18, 2001 :
Attorney Docket No.: 07-18673 :

This is in response to the petition, presumably filed under 37 CFR § 1.181, and filed March 30, 2009, requesting that the finality of the Office action of December 29, 2008 be withdrawn.

It is noted that applicants filed this petition under 37 CFR § 1.181 on March 30, 2009 requesting relief from the finality of the Office action mailed December 29, 2008. This petition was not filed within two months from the mailing of the final Office action and is thus untimely. Nevertheless, a decision on this petition is rendered herein.

BACKGROUND

Recently, the examiner mailed a final Office action on December 29, 2008 setting a three month statutory limit for reply. At the time of this final Office action, claims 20, 22-31, 35, 36, and 40-44 were pending and were examined on their merits. Claims 32-33, 37-39 were withdrawn from consideration. The examiner maintained the rejection of claims 20-31, 34-36 and 40-44 under 35 USC 103(a) as being unpatentable over Lin et al. in view of Williams, Yan et al, Mayer et al and Hoistege et al. It is noted that claims 21 and 34 were cancelled by applicants and that these claims should not have been rejected again by the examiner.

In response thereto, applicants filed this petition on March 30, 2009, requesting that the finality of the Office action of December 29, 2008 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on March 30, 2009, applicants requests reconsideration of the finality rendered in the Office action mailed by the examiner on December 29, 2008 because it is considered that the Office action did not substantively address Applicants' arguments.

Specifically, applicants argue that "The Examiner's response to the Applicants' arguments is limited to a single assertion that "it is... clear that some or most of the neuropathic or nerve damaged patients suffer from pain." (page 5, Office Action). This assertion appears to be an attempt to address the Applicants' point that the Lin *et al.* reference must necessarily include administration of GDNF to a subject suffering from pain to meet a required claim limitation.

Applicants also allege "The Examiner has not responded to any of Applicants' other arguments in the response filed September 17, 2008. Specifically, Applicants have also argued that:

- 1) None of the references teach or suggest administering amounts of GDNF effective to alleviate pain.
- 2) Williams *et al.* does not teach or suggest administering GDNF to a human suffering from pain.
- 3) Mayer *et al.* does not teach what the Examiner claims it teaches. Mayer *et al.* only *speculates* that neuropathic pain is caused by damage to peripheral nerves.
- 4) Holstege *et al.* does not teach what the Examiner claims. Holstege *et al.* merely *speculates* that GDNF *may* be involved in nociception.
- 5) The fact pattern established by the references is exactly the *inverse* of the fact pattern that the Examiner attempts to show to establish a basis for the rejection.
- 6) None of the references, alone or in combination, teach or suggest that the administered GDNF alters tetrodotoxin-resistant sodium ion current in neuronal cells, a required claim limitation.

The Examiner has not provided any substantive response to any of these points. Applicants respectfully submit that examination cannot progress if the Examiner does not articulate the basis for any disagreement with a submitted argument. In light of the incompleteness of the Examiner's answer to Applicants' arguments, Applicant respectfully submits that the Finality of the Office Action mailed on December 29, 2008 was premature, and respectfully requests its withdrawal."

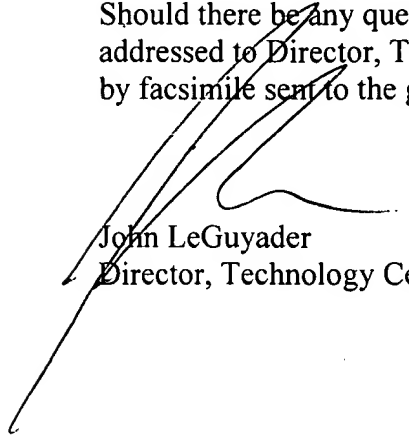
Applicants' arguments are persuasive because the examiner failed to fully address the arguments set forth in the response of September 17, 2008. Thus, the final Office action of December 29, 2008 is considered incomplete and the finality of said Office action will be withdrawn.

DECISION

The petition is **GRANTED.**

This application will be forwarded to the examiner for proper and complete consideration of applicants arguments submitted September 17, 2008.

Should there be any questions about this decision please contact Marianne C. Seidel, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.



John LeGuyader
Director, Technology Center 1600